

THIS DISPOSITION IS NOT  
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OF THE TTAB

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Paper No. 16  
Bottorff

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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Wallyball International, Inc.

v.

Joe Garcia  
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Opposition No. 120,198  
to application Serial No. 75/707,289  
filed on May 17, 1999  
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Edward W. Pilot for Wallyball International, Inc.

Joe Garcia, pro se.  
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Before Simms, Bottorff and Drost, Administrative  
Trademark Judges.

Opinion by Bottorff, Administrative Trademark Judge:

In the above-referenced application, applicant seeks registration on the Principal Register of the mark MR. WALLYBALL, in typed form, for goods identified in the application, as amended, as "t-shirts, wrist bands, sweatshirts, caps and shorts" in Class 25, and "wallyball balls" in Class 28. As to the Class 28 goods only,

**Opposition No. 120,198**

applicant has disclaimed the exclusive right to use WALLYBALL apart from the mark as shown. The application is based on applicant's asserted bona fide intention to use the mark in commerce. Trademark Act Section 1(b), 15 U.S.C. §1051(b).

On August 25, 2000, opposer filed a timely notice of opposition to registration of applicant's mark as to both classes of goods. In the notice of opposition, opposer appears to be attempting to allege<sup>1</sup> the following as grounds of opposition: likelihood of confusion vis-à-vis opposer's previously-used "WALLYBALL INTERNATIONAL & DESIGN" mark, under Trademark Act Section 2(d), 15 U.S.C. §1052(d); unfair competition, under Trademark Act Section 43(a), 15 U.S.C. §1125(a); dilution, under Trademark Act Section 43(c), 15 U.S.C. §1125(c); and breach by applicant of a non-competition agreement between the parties. We shall discuss each of these grounds, *infra*.

In his answer to the notice of opposition, applicant denied all of the allegations in the notice of opposition, except that he admitted that opposer has used the stylized mark described in the notice of opposition on "clothing, equipment and accessories" since 1985, that opposer is the owner of an abandoned application and a

newly-filed application to register that mark, and that applicant was formerly a minority shareholder in opposer corporation and that he surrendered his shares in April 1999.

Neither party properly made any evidence of record. The numerous exhibits attached to each party's pleading were not properly made of record during the parties' respective testimony periods, and they therefore are not evidence in this case. See Trademark Rule 2.122(c), 37 C.F.R. §2.122(c); TBMP §704.05 (2d ed. June 2003). During its testimony period, opposer submitted the July 2001 "declaration" of its president and CEO, Michael O'Hara, along with exhibits thereto consisting of the exhibits which were attached to the notice of opposition as well as two additional exhibits. However, the testimony of a witness may be submitted in affidavit or declaration form only by written agreement of the parties. Trademark Rule 2.123(b), 37 C.F.R. §2.123(b). No such written agreement is of record, and we therefore have given no consideration to the O'Hara declaration or its exhibits. See Trademark Rule 2.123(l), 37 C.F.R. §2.123(l) ("Evidence not obtained and filed in compliance

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<sup>1</sup> Opposer's pleading is hardly a model of clarity.

with these sections will not be considered"). Applicant submitted no evidence during his testimony period. Opposer attached evidence to its brief on the case, including a February 2003 declaration by Michael O'Hara (which, in essence, is a verbatim repetition of his earlier July 2001 declaration) and exhibits thereto (which essentially are the same exhibits as those attached to his earlier declaration and to the notice of opposition). Evidence attached to briefs is untimely and will not be considered. See TBMP §704.05 (2d ed. June 2003).

Thus, the evidence of record in this case consists of the file of the opposed application (see Trademark Rule 2.122(b), 37 C.F.R. §2.122(b)), the above-referenced factual admissions contained in applicant's answer to the notice of opposition (see TBMP §704.06(a)(2d ed. June 2003), and two dictionary definitions of the word "wallyball" of which we take judicial notice (see discussion *infra*). We note, however, that even if we were to deem the materials the parties have submitted to have been timely and properly made of record, our decision in this case would be the same.

Opposer filed a brief on the case (which consists in large part of a mere verbatim repetition of the

**Opposition No. 120,198**

allegations contained in the notice of opposition).

Applicant did not file a brief. Neither party requested an oral hearing.

In view of applicant's admission (in Paragraph 1 of his answer to the notice of opposition) that opposer has used a mark which incorporates the term "wallyball" since 1985, we find that opposer has standing to bring this opposition proceeding. *See, e.g., Lipton Industries, Inc. v. Ralston Purina Company*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

We turn now to a discussion of the grounds of opposition asserted by opposer in this case. First, we note that the Board has no jurisdiction over claims of unfair competition, and that such claims (whether asserted under Section 43(a) of the Lanham Act or otherwise) are not available as grounds of opposition in proceedings before the Board. *See* TBMP §102.01 (2d ed. June 2003), and cases cited therein. Accordingly, to the extent that opposer's allegations in the notice of opposition (including, especially, the allegations in Paragraphs 8, 10 and 12) can be construed as opposer's attempt to plead unfair competition as a ground of opposition, we have given those allegations no consideration.

Opposer also has alleged that applicant and opposer entered into a non-competition agreement in 1999, and that applicant breached that agreement by filing the intent-to-use application involved in this proceeding. The Board has no jurisdiction to consider a breach of contract claim, per se. We shall assume that opposer is attempting to assert a claim based on the theory of "estoppel by agreement," i.e., that applicant's prior agreement with opposer estops applicant from filing the present application. See, e.g., *M-5 Steel Mfg Inc. v. O'Hagin's Inc.*, 61 USPQ2d 1086, 1095 (TTAB 2001), and cases cited therein. We find, however, that opposer has failed to prove such a claim. In his answer to the notice of opposition, applicant denied the existence of a non-competition or any other agreement between the parties, and opposer has failed to present any evidence that such an agreement exists, much less that applicant breached it by filing his application.<sup>2</sup> Opposer's ground

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<sup>2</sup> Mr. O'Hara's July 2001 and February 2003 declarations are not evidence of record, for the reasons discussed above. Moreover, we note that Mr. O'Hara's assertion in these declarations regarding the existence of a non-competition agreement between the parties is an essentially verbatim repetition of the allegation in the notice of opposition pertaining to such agreement, an allegation which was expressly denied by applicant in his answer to the notice of opposition. Even if Mr. O'Hara's declaration were deemed to be of record (it is not), it does not suffice to prove opposer's claim. Similarly, the April 14, 1999 letter from Mr. O'Hara to applicant (Exhibit E to opposer's

of opposition based on the alleged existence and breach of such agreement accordingly is dismissed.

Opposer, in the notice of opposition, makes two references to dilution (in paragraphs 9 and 14). However, opposer has failed to allege facts which are essential to a claim of dilution, including, e.g., that its mark is famous and became famous prior to the filing date of applicant's application. See, e.g., *Toro Co. v. ToroHead, Inc.*, 61 USPQ2d 1164 (TTAB 2001). Moreover, even if we were to deem opposer's pleading to be sufficient and opposer's evidence to have been properly made of record (it was not), that evidence fails to establish even a prima facie case of dilution. Accordingly, to the extent that opposer might be deemed to be asserting dilution as a ground of opposition, that ground is dismissed.

Thus, opposer's Section 2(d) claim of priority and likelihood of confusion is the only ground of opposition remaining for consideration. In Paragraph 1 of his answer to the notice of opposition, applicant admits that opposer has used opposer's mark since 1985, a date prior

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notice of opposition, to Mr. O'Hara's declarations, and to opposer's brief) is not properly of record, and even it were, it fails to establish the existence of a non-competition or any other agreement between the parties which would preclude applicant from filing the application.

to the filing date of applicant's intent-to-use application (which is the earliest date upon which applicant can rely for priority purposes in this case). In view thereof, we find that Section 2(d) priority rests with opposer in this case.

We turn next to the issue of likelihood of confusion. Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the likelihood of confusion factors set forth in *In re E.I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We first shall determine whether applicant's goods and opposer's goods are similar or dissimilar, under the second *du Pont* evidentiary factor. As noted above, opposer failed to properly make any evidence of record, including any evidence as to the nature of the goods or

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services on which it uses its mark. However, in Paragraph 1 of the notice of opposition, opposer alleged that it uses its mark on "official Wallyball products including kits (ball, net, net tightener, storage bag, official rule book, hardware and installation instructions), banners, suction cups, and clothes, including T-shirts, jerseys, jackets, shorts and sweat pants." In his answer, applicant responded to this allegation by admitting that opposer uses its mark "on equipment, clothing and accessories." In Paragraph 2 of the notice of opposition, opposer alleged that it "has been the governing body of Wallyball since on or about September 18, 1985 and since that date has been exclusively and continuously promoting the sport by conducting and sponsoring games, tournaments and championships," all of which opposer (correctly) asserts are Class 41 services. In his answer to Paragraph 2, applicant did not deny that opposer provides these alleged services, but merely denied opposer's allegation that it is the exclusive provider of such services.

In view of these admissions by applicant, we find that opposer's goods and services, for purposes of our Section 2(d) likelihood of confusion analysis, comprise those goods and services alleged in Paragraphs 1 and 2 of

**Opposition No. 120,198**

the notice of opposition, i.e., goods consisting of "kits [for playing the game of wallyball, comprising] (ball, net, net tightener, storage bag, official rule book, hardware and installation instructions), banners, suction cups, and clothes, including T-shirts, jerseys, jackets, shorts and sweat pants," and services consisting of "promoting the sport [of wallyball] by conducting and sponsoring games, tournaments and championships."

Applicant's goods, for purposes of our likelihood of confusion analysis, are the goods identified in the application, i.e., "t-shirts, wrist bands, sweatshirts, caps and shorts" in Class 25, and "wallyball balls" in Class 28.

We find that applicant's goods, in both Class 25 and Class 28, are legally identical to opposer's goods in part ("balls," "t-shirts" and "shorts") and otherwise are closely related thereto, and that applicant's goods also are related to opposer's services. This similarity in the parties' respective goods and services weighs in opposer's favor in our likelihood of confusion analysis.

We also find that applicant's goods and opposer's goods (and, to perhaps a lesser extent, opposer's services) are of the type which are or would be marketed in the same trade channels and to the same classes of

purchasers. These factors also support a finding of likelihood of confusion.

We next must determine whether applicant's mark and opposer's mark, when compared in their entireties in terms of appearance, sound and connotation, are similar or dissimilar in their overall commercial impressions. The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Furthermore, although the marks at issue must be considered in their entireties, it is well-settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Finally, where, as in the present case, the marks would appear on virtually identical goods, the

degree of similarity between the marks which is necessary to support a finding of likely confusion declines.

*Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

In the notice of opposition, opposer alleged that its mark is "WALLYBALL INTERNATIONAL & DESIGN," said design consisting of a "distinctive lightening [sic] bolt 'W' emblem and blue and gold colors." (Notice of opposition, ¶ 1.) Opposer also alleged ownership of (and attached a copy of) a pending application, executed October 29, 1999, for registration of the mark depicted below for goods in Classes 25, 28, and 41.



In his answer, applicant admitted that opposer is the prior user of the mark described in Paragraph 1 of the notice of opposition, and that opposer is the owner of the above-referenced application for registration of that mark. Because the mark depicted above (from opposer's application) is essentially the same as the mark pleaded by opposer (and admitted by applicant), we deem it to be

the mark on which opposer's claim is based, for purposes of our likelihood of confusion analysis.<sup>3</sup> Thus, the issue for determination under the first *du Pont* factor is whether applicant's mark MR. WALLYBALL and opposer's mark WALLYBALL INTERNATIONAL, INC. & DESIGN, when viewed in their entirety, are similar or dissimilar when compared in accordance with the legal principles outlined above.

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<sup>3</sup> Review of the Office's automated records reveals that the above-referenced application for registration of this mark, filed by opposer on October 29, 1999 (a date subsequent to the filing date of applicant's involved intent-to-use application), was abandoned on January 27, 2001 due to opposer's failure to respond to an Office action. However, opposer pleaded (and applicant admitted) prior common law rights in this mark as well, and it is those pleaded common law rights upon which opposer's Section 2(d) claim therefore is based in this case.

In its brief on the case, opposer for the first time asserted that it is the owner of Registration No. 2,627,516, issued October 1, 2002 from an application filed July 8, 2001, of the mark depicted below for goods identified in the registration as "sports balls, namely, a type of volleyball."



In the registration, opposer has disclaimed the word WALLYBALL apart from the mark as shown. A copy of the registration (although not a status and title copy - see Trademark Rule 2.122(d)) is attached as Exhibit C to opposer's brief. This mark was not pleaded in the notice of opposition as a basis for opposer's Section 2(d) claim, and, in any event, opposer has failed to prove the status and title of the registration with timely and competent evidence. Accordingly, we find that opposer's mark, for purposes of our likelihood of confusion analysis in this case, is the "WALLYBALL INTERNATIONAL & DESIGN" mark pleaded in the notice of opposition (as depicted in the main text of this opinion), and not the mark depicted in the registration. We note, however, that our decision would be the

We find that the marks obviously are similar in terms of appearance and sound to the extent that they both include the word WALLYBALL. The marks differ in terms of appearance and sound in that applicant's mark, but not opposer's mark, includes the term "MR.," and in that opposer's mark, but not applicant's mark, includes the words INTERNATIONAL, INC., as well as distinctive design elements. In terms of connotation, the marks are similar to the extent that they both refer to the sport of wallyball, but are different to the extent that applicant's mark connotes a person named (or nicknamed) "Mr. Wallyball," while opposer's mark carries no such connotation.

Comparing the marks in terms of their overall commercial impressions, we find that the similarity which results from the fact that the word WALLYBALL appears in both marks is outweighed by the dissimilarities in appearance, sound and connotation which result from the presence of the word "MR." in applicant's mark. The word WALLYBALL is highly descriptive, if not generic, as applied to the parties' respective wallyball-related

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same in this case even if we were to consider opposer's registered mark to have been pleaded and made of record.

goods and services. We take judicial notice<sup>4</sup> that The American Heritage Dictionary of the English Language (4<sup>th</sup> ed. 2000), at pp. 1936-37, defines "wallyball" as follows: "noun : a game similar to volleyball played on a four-walled court with a ball the same size as but harder than a volleyball that is allowed to bounce once off the ceiling or one of the walls before being returned over the net." We also take judicial notice that The New Oxford American Dictionary (2001), at p. 1899, similarly defines "wallyball" as follows: "n. a game played on a four-walled court with rules similar to volleyball, and with a ball the same size as but harder than a volleyball. The ball is allowed to bounce once against the ceiling or one of the walls before being returned over the net." "Wallyball" clearly is the name of the sport itself, and thus is a generic or highly descriptive term in which neither party can assert exclusive proprietary rights. The Board previously has held as much. *See In re Wallyball, Inc.*, 222 USPQ 87 (TTAB 1984). Indeed, applicant has disclaimed the exclusive

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<sup>4</sup> The Board may take judicial notice of dictionary definitions. *See, e.g., University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); *see also* TBMP §704.12 (2d ed. June 2003).

**Opposition No. 120,198**

right to use the term as to his Class 28 goods, as has opposer in its registration (see *supra* at footnote 3).

In the notice of opposition, opposer has alleged that its mark is distinctive, but the evidence of record simply fails to support that allegation insofar as the term WALLYBALL is concerned.

If the common element of two marks is "weak" in that it is generic, descriptive or highly suggestive of the named goods or services, consumers typically will be able to avoid confusion unless the overall combinations have other commonality. See, e.g., *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986) (BED & BREAKFAST REGISTRY for making lodging reservations for others in private homes held not likely to be confused with BED & BREAKFAST INTERNATIONAL for room booking agency services); *The U.S. Shoe Corp. v. Chapman*, 229 USPQ 74 (TTAB 1985) (COBBLER'S OUTLET for shoes held not likely to be confused with CALIFORNIA COBBLERS (stylized) for shoes); *In re Istituto Sieroterapico E Vaccinogeno, Toscano "SCLAVO" S.p.A.*, 226 USPQ 1035 (TTAB 1985) (ASO QUANTUM (with "ASO" disclaimed) for diagnostic laboratory reagents held not likely to be confused with QUANTUM I for laboratory instrument for analyzing body



fluids). In the present case, no such other commonality exists between the marks.

Given the highly descriptive nature of the word WALLYBALL, we find that presence of the term "MR." In applicant's mark suffices to distinguish applicant's mark from opposer's mark in terms of their overall commercial impressions. The dominant feature in the commercial impression created by applicant's mark, when that mark is viewed in its entirety, is the mark's "personalized" connotation; the mark will be perceived and recollected as identifying and referring to a person, i.e., someone called "Mr. Wallyball." Whether that person is understood by purchasers to be applicant himself (who asserts that he is "Mr. Wallyball" by virtue of the fact that he allegedly invented the game), or is instead understood to refer to any person who is an enthusiast of the game of wallyball, or to a fanciful person or persona, it is clear that applicant's mark has a connotation and a commercial impression which opposer's mark simply does not have. That dissimilarity in the mark's connotations renders the marks dissimilar, for purposes of the first *du Pont* evidentiary factor.

**Opposition No. 120,198**

After careful consideration of the relevant *du Pont* evidentiary factors in this case, we conclude that opposer has failed to establish that a likelihood of confusion exists. Notwithstanding the identical and closely related nature of the goods involved in this case, we find that the respective marks are sufficiently distinguishable that no confusion is likely. See *Kellogg Co. v. Pack'Em Enterprises Inc.*, 14 USPQ2d 1545 (TTAB 1990), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991).

Decision: The opposition is dismissed.